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25 SEP 2006

RANBAXY INC.  
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In re Application of SINGH et al.  
Application No.: 10/522,223  
PCT No.: PCT/IB03/02962  
Int. Filing: 24 July 2003  
Priority Date: 25 July 2002  
Attorney Docket No.: RLL-255US  
For: PROCESSES FOR THE PREPARATION OR ORAL  
DOSAGE FORMULATIONS OF MODAFINIL

DECISION ON  
PETITION  
UNDER 37 CFR 1.47(a)

This is a decision on applicant's petition under 37 CFR 1.47(a) filed in the United States Patent and Trademark Office (USPTO) on 08 March 2006 and refiled along with a supplemental petition on 07 June 2006.

#### BACKGROUND

On 24 January 2005, applicant filed a transmittal letter (PTO-1390) requesting entry into the national stage in the United States of America under 35 U.S.C. § 371. Filed with the Transmittal Letter was, *inter alia*, the requisite basic national fee.

On 08 August 2005, a Notification of Missing Requirements (FORM PCT/DO/EO/905) was mailed to applicant indicating that an oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), and the surcharge for filing the oath or declaration after the thirty month period, was required.

On 08 March 2006, via facsimile, in response to the Notification of Missing Requirements, applicant apparently filed a petition under 37 CFR 1.47(a) in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4). The petition requested the acceptance of the application without the signature of inventors Romi Barat Singh, Pananchukunnath Manoj Kumar, and Vishnubhotla Nagaprasad. This petition is not found among the USPTO records.

On 07 June 2006, applicant filed a supplemental petition under 37 CFR 1.47(a) along with declarations signed by the inventors.

#### DISCUSSION

The Notification of Missing Requirements (FORM PCT/DO/EO/905) mailed on 08 August 2005 set a two month time period within which to respond or by 08 October 2005. Extensions of time under 37 CFR 1.136 were available.

The petition under 37 CFR 1.47(a) allegedly filed via facsimile on 08 March 2006 is not

found in the USPTO records. On 07 June 2006, applicant filed an incomplete copy of the 08 March 2006 petition along with a supplemental petition under 37 CFR 1.47(a). The petition is being considered under 37 CFR 1.8(b).

Acceptance of the Petition under 37 CFR 1.8(b)

37 CFR 1.8(b) states:

In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the Patent and Trademark Office, and the application is held to be abandoned or the proceeding is dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:

- (1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;
- (2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and
- (3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Commissioner to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.

The evidence filed with the present petition does not satisfy the requirements of 37 CFR 1.8(b). The cover sheet for the 08 March 2006 petition indicates that the facsimile was comprised of 7 pages, including the cover page. The 07 June 2006 petition included a copy of the transmission report along with the facsimile cover sheet and a copy of only two (2) pages of the 08 March 2006 petition.

Applicant has not: (1) informed the Office of the previous mailing of the correspondence promptly after becoming aware that the Office did not receive the items by facsimile on 08 March 2006, (2) supplied complete copies of the previously faxed correspondence; and (3) provided a copy of the sending unit's report confirming transmission on 08 March 2006 with a statement which attests on a personal knowledge basis to the previously timely transmission as required by 37 CFR 1.8(b). Applicants' petition under 37 CFR 1.8(b) is **DISMISSED WITHOUT PREJUDICE**.

Moreover, the petition submitted on 08 March 2006 will not be considered as timely response to the Notification of Missing Requirements mailed 08 August 2006. A five month extension of time is required. Thus, the application was abandoned on 08 March 2006 for failure to file a timely respond to the Notification of Missing Requirements.

**CONCLUSION**

The application is **ABANDONED**.

As set forth above, applicant may wish to file a petition under 37 CFR 1.8(b) along with a complete copy of the Response to the Notification of Missing Requirements, requesting withdrawal the holding of abandonment.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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